


PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number Q67539	
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number	Filed	
	10/000,219	December 4, 2001	
	First Named Inventor Masafumi NISHITANI		
	Art Unit	Examiner	
	1764	Thanh P. DUONG	
<p style="text-align: center;">WASHINGTON OFFICE 23373 CUSTOMER NUMBER</p>			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reasons(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record. Registration number <u>50,245</u></p> <div style="text-align: right;">  Signature </div> <div style="text-align: right;"> <u>Brian K. Shelton</u> Typed or printed name </div> <div style="text-align: right;"> <u>(202) 293-7060</u> Telephone number </div> <div style="text-align: right;"> <u>March 20, 2007</u> Date </div>			

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q67539

Masafumi NISHITANI, et al.

Appln. No.: 10/000,219

Group Art Unit: 1764

Confirmation No.: 9175

Examiner: Thanh P. DUONG

Filed: December 4, 2001

For: GOLF CLUB

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Program, and further to the Examiner's Final Office Action dated December 20, 2006, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue¹:

a. Rejections under 35 U.S.C. § 102/103 based on Chen

Claims 1, 3-7, 10-12, 17-26, 33-40 and 43-45 stand rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Chen (U.S. Patent No. 6,368,233). Applicant submits that the rejection of these claims is improper, at least for the following reasons.

For instance, Applicant has noted that Chen failed to disclose a striking face including a plurality of metal pieces, as recited by claim 1. *See* Response of September 26, 2006

¹ Applicant reserves the right to present additional arguments as to separate patentability of any of the pending claims in the event that this matter proceeds to the Board of Appeals.

(“Response”) at pages 5-6. Applicant has further noted that the Examiner has failed to provide any supporting rationale for the alleged interpretation of a transitional arcuate piece, which is never described by Chen as being any part of a striking face, as being a piece of the striking face itself. *See* Response at page 6.

In response, the Examiner contends “Chen clearly discloses the *striking face (60)* is formed of a main piece 62 of titanium and an arcuate piece of [*sic*] of stainless steel.” *See* Office Action at page 10 (emphasis added). However, contrary to the Examiner’s contention, element 60 does not refer to a striking face, but a “front shell 60”, which includes a “main piece 62 of titanium, and an arcuate piece 64 of stainless steel.” *See* Chen at col. 2, lines 62-64. Thus, the “arcuate piece” cannot reasonably be interpreted as a member of a striking face for the reasons previously argued, and the Examiner has failed to properly address the substance of Applicant’s arguments.

In addition, Applicant has noted, with reference to the technical explanation set forth in the 132 Declaration, that the structure resulting from the claimed laser welded golf club is distinct from Chen’s teaching of using conventional welding techniques. *See* Response at pages 6-9. Without affording proper consideration to these arguments, the Examiner simply asserts that “It is submitted that such argument is directed to the method of forming the striking face”. *See* Office Action at pages 10-11. Applicant again submits that the Examiner has not properly considered the structural distinctions vis-à-vis Chen and the golf club of claim 1, which cannot properly be dismissed as simply being “directed to a method of production.”

Applicant further submits that the Examiner’s conclusory contention that “there is nothing unobvious about providing [a] conventional laser welding technique to club parts over conventional welding techniques since laser welding is more precise and has less heat affecting area, which minimizes corrosion and cracking” is plainly insufficient to support the allegation of *prima facie* obviousness. *See* Office Action at page 11.

Initially, as previously argued, the Examiner’s statements themselves evidence structural distinctions between laser welding and conventional welding. *See* Amendment filed February 6, 2006 at pages 16-17. Moreover, the Examiner provides no objective evidence to support his

contention that modifying the teaching of Chen would have been obvious. *See* Response at pages 11-14.

At least for the foregoing reasons, Applicant submits that the rejection of claim 1 is in error. The rejection of independent claims 7, 21, and 24 based on Chen is in error for analogous reasons. *See* Response at pages 14-16.

b. Rejections under 35 U.S.C. § 102/103 based on Ciasullo

Claims 24-26, 40 and 46 stand rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Ciasullo (U.S. Patent No. 6,739,984). Applicant submits that the rejection of these claims is improper, as evidenced below.

For instance, the Examiner fails to give proper consideration to the arguments advanced in the response and the 132 Declaration regarding the structural differences between the golf club defined by independent claim 24 and Ciasullo as follows:

With respect to the argument of Ciasullo's reference,
Applicants argue the inner and out shells are bonded by explosion
welding not laser welding. Again, such argument is directed to the
method of production which does not impart structural limitation
to the claimed invention.

See Office Action at page 11.

As with the structural distinctions Applicant noted with respect to Chen, the Examiner likewise fails to give proper consideration to the arguments regarding the distinctions between Ciasullo's teaching of explosion welding and the laser welding structure of the golf club of the present invention. Likewise, the Examiner has not properly considered the arguments directed to the conclusory nature of the allegation of obviousness, which is insufficient to establish *prima facie* obviousness. *See* Response at pages 17-20

At least for the foregoing reasons, Applicant submits that the rejection of independent claim 24 is in error.

c. Rejections under 35 U.S.C. § 103 based on Kosugi in view of Shaw

Claims 1, 3-7, 9-12, 15-23, and 43-44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kosugi et al. (6,106,412) in view of Shaw et al. '535. In the Office Action, the Examiner states "With respect to the argument of Kosugi' [sic] reference, Chen's comment with respect to laser welding and press-forming of metal pieces applies here." See Office Action at page 11.

However, the Examiner does not specifically address the deficiencies of Kosugi noted in Applicant's prior Response, such as the argument that Kosugi would teach away from the claimed invention. See Response at page 26-30. Rather, the Examiner simply contends that his response for the rejections based on Chen also apply.

As such, the Examiner has not properly responded to the substance of the arguments and this ground of rejection is improper at least for the reasons previously advanced.

d. Rejections under 35 U.S.C. § 103 based on Peterson

Claims 27-29, 41 and 47 stand rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Peterson (U.S. Patent No. 6,339,869). Applicant notes that the Examiner does not even address the arguments regarding the claim rejections based on Peterson in his Response to Arguments. See Response at pages 10-11.

Thus, the Examiner has not only failed to give proper consideration to Applicant's arguments, but he has neglected to respond to them at all. Accordingly, this ground of rejection is improper and reversal is requested.

e. Rejections under 35 U.S.C. § 102/103 based on Galy

Claims 30-32, 42 and 48 stand rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Galy (U.S. Patent No. 5,971,867). In responding to Applicant's arguments against the rejections based on Galy, the Examiner simply alleges that "Chen's comment with respect to laser welding and press-forming of metal pieces applies here." See Office Action at page 11.

As with Chen, Applicant submits that the Examiner has not properly responded to the substance of Applicant's arguments, as set forth, e.g., at pages 24-25 of the Response. Accordingly, Applicant submits that this ground of rejection is improper for reasons analogous to those discussed above.

At least for the foregoing reasons, Applicant submits that the outstanding rejections are improper, and reversal is respectfully requested.

Respectfully submitted,



Brian K. Shelton
Registration No. 50,245

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

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